

**REMARKS**

I. **Introduction**

In response to the pending Office Action, Applicants have amended the specification to correct the informalities as indicated on page 2 of this paper.

The amendment to claim 1 is supported by original claim 3 and page 11 paragraph 44 of the specification. The amendment to claim 9 is supported by original claims 3 and 10 and page 11 paragraph 44 of the specification. Claims 3 and 8 have been amended for clarification.

New claims 11 and 12 have been added. New claim 11 is supported by original claim 1 and Figs. 3, 5 and 6. New claim 12 is supported by original claim 9 and Fig. 3. Claims 2-4, 6 and 10 have been amended to maintain proper dependency.

No new matter is introduced by this Amendment.

II. **Rejections under 35 U.S.C. § 112, second paragraph**

The Examiner alleges that claims 3 and 8 are indefinite under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Regarding claim 3, the Examiner asserts that it is unclear what the final compressed thickness would be. Applicants have amended the claim to obviate this rejection.

Regarding claim 8, the Examiner asserts that the term “substantially” is a relative term rendering the claim indefinite. Applicants have amended the claim to obviate this rejection.

Accordingly, Applicants respectfully request that the rejection be withdrawn and the claims allowed.

**III. Rejections under 35 U.S.C § 102(b)**

**A. Kato et al. (U.S. Patent Publication 2002/0187384 A1)**

The Examiner rejected claims 1, 2, 4, 9 and 10 as allegedly being anticipated by Kato et al., this rejection is respectfully traversed.

As to claims 1 and 9, applicants have amended the claims to incorporate the limitations of original claim 3, the sole basis of rejection of which was under 35 U.S.C. § 112 for allegedly being indefinite for not clearly stating the final compressed thickness difference. Furthermore, amended claims 1 and 9 have been amended to clarify the final compressed thickness difference.

As such, Applicants submit that the rejection is obviated and the claims are allowable.

The dependent claims are allowable for at least the same reasons as the respective independent claims from which they dependent and further distinguish the claimed fuel cell and method.

In addition, new claims 11 and 12 recite that at least one of the separators has a groove to form a hollow space over an edge of at least one of the pair of electrodes, and the groove is isolated from the gas channels.

Kato discloses a seal structure with an oxidant gas passage 27b that is part of the gas channel, (Kato page 2 paragraph 35). Kato at a minimum fails to disclose a groove that is isolated from the gas channels as claimed.

Accordingly, Applicants respectfully submit that claims 11 and 12 are allowable.

**B. Tsutomu (JP Publication Number 08-148170)**

The Examiner rejected claims 1, 2, and 5-8 as allegedly being anticipated by Tsutomu this rejection is respectfully traversed.

As to claim 1, Applicants have amended the claims to incorporate the limitations of original claim 3, which was rejected under 35 U.S.C. § 112 as discussed above.

Accordingly, Applicants submit that the rejection is moot and the claim is allowable.

Dependent claims 2 and 5-7 are allowable for at least the same reasons as independent claim 1 from which they dependent and further distinguish the claimed fuel cell.

Furthermore, as recited by pending claim 8, the present invention relates to a separator for contacting an electrode of a fuel cell having a groove therein that is isolated from any gas channel and approximately positioned over an outer edge of an electrode fuel cell. As a result, as explained in detail in the specification, gas flow into the groove during the operation of the fuel cell can be prevented.

Turning to the cited prior art reference, Tsutomu discloses a groove that is part of a gas channel, not isolated from any gas channel as claimed. As seen in Figs. 1 and 4, the gas channels 6 and 7 of Tsutomu are in contact with the groove.

Accordingly, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Tsutomu fails to disclose a separator for contacting an electrode of a fuel cell having a groove therein that is isolated from any gas channel and approximately positioned over an outer edge of an electrode fuel cell, it is clear that Tsutomu does not anticipate claim 8.

New claims 11 and 12 recite that at least one of the separators has a groove to form a hollow space over an edge of at least one of the pair of electrodes, and the groove is isolated from the gas channels.

As discussed above, Tsutomu fails to disclose a separator for contacting an electrode of a fuel cell having a groove therein that is isolated from any gas channel.

Furthermore, the groove disclosed by Tsutomu is not hollow, but filled with a packing or gasket as stated by the Examiner.

For at least these reasons, Applicants respectfully request that the claims are patentable over Tsutomu

**IV. Rejections under 35 U.S.C § 102(e)**

**A. Artibise (U.S. Patent Number 7,070,876 B2)**

The Examiner rejected claims 1, 2, and 5-8 as allegedly being anticipated by Artibise. This rejection is respectfully traversed.

As to claim 1, Applicants have amended the claim to incorporate the limitations of original claim 3, the sole basis of rejection of which was under 35 U.S.C. § 112 for allegedly being indefinite.

Accordingly, Applicants submit that the rejection of claim 1 is moot and the claim is allowable.

Dependent claims 2 and 5-7 are allowable for at least the same reasons as independent claim 1 from which they dependent and further distinguish the claimed fuel cell.

Furthermore, as recited by pending claim 8, the present invention relates to a separator for contacting an electrode of a fuel cell having a groove therein that is isolated from any gas channel and approximately positioned over an outer edge of an electrode fuel cell. As a result, as explained in detail in the specification, gas flow into the groove during the operation of the fuel cell can be prevented.

Artibise discloses a membrane electrode assembly with an impregnated material creating a seal. Artibise at a minimum fails to disclose a separator with a groove that is isolated from any gas channel and approximately positioned over an outer edge of an electrode fuel cell as claimed. Moreover, the Examiner makes no mention any grooves in Artibise.

As such, Applicants respectfully submit that Artibise fails to anticipate claim 8.

New claims 11 and 12 recite that at least one of the separators has a groove to form a hollow space over an edge of at least one of the pair of electrodes, and the groove is isolated from the gas channels.

As stated above, Artibise fails to disclose a separator for contacting an electrode of a fuel cell having a groove therein that is isolated from any gas channel.

Accordingly, Applicants submit that claims 11 and 12 are allowable.

In view of the above amendments and remarks, Applicants submit that this application be allowed and passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

**Application No.: 10/823,796**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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